

6-1-92
The opinion in support of the remand being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 30

MAILED **UNITED STATES PATENT AND TRADEMARK OFFICE**

APR 25 2002

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. SULLIVAN, JOHN L. NEALON and MARK BINETTE

Appeal No. 2002-0260
Application No. 08/926,872

ON BRIEF

Before GARRIS, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

REMAND

This application is being remanded to the examiner for appropriate action.

Claims 1 and 3 to 8 stand rejected under 35 U.S.C. § 112, first paragraph, as
containing subject matter which was not described in the specification in such a way as
to reasonably convey to one skilled in the relevant art that the appellant, at the time the

application was filed, had possession of the claimed invention. The examiner found that certain limitations of claim 1 lack proper support in the originally filed specification (see page 3 of the examiner's answer (Paper No. 27, mailed March 22, 2001)).

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Finally, "[p]recisely how close the original description must come

to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116). A rejection on the description requirement is fully defeated by a specification which describes the invention in the same terms as the claims. See In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974). Furthermore, an original claim is part of the original disclosure. See In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397, supplemental opinion, 480 F.2d 879, 879-80, 178 USPQ 149 (CCPA 1973) and In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

We remand this application to the examiner to determine if the above-noted rejection of claims 1 and 3 to 8 is appropriate in view of the subject matter of claims 1 to 8 as originally filed in the application. In this regard, we note that each specific limitation which the examiner has found to lack proper support in the originally filed specification appears to find proper support in the originally filed claims which are part of the originally filed specification. If the examiner determines that the rejection is not appropriate, the examiner should withdraw the rejection. If the examiner determines that the rejection is still appropriate, the examiner should provide a detailed explanation

as to why current claims 1 and 3 to 8 do not find written description support as required by the first paragraph of 35 U.S.C. § 112 in claims 1 to 8 as originally filed.

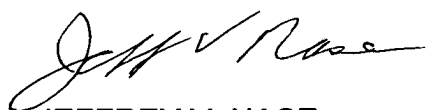
This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

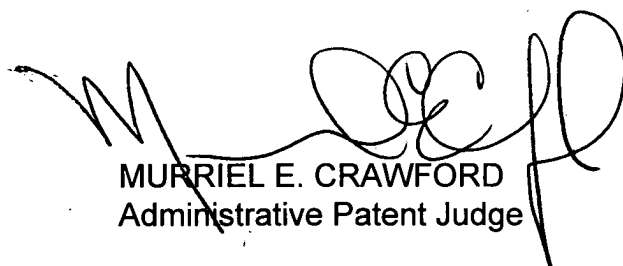
If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

REMANDED


BRADLEY R. GARRIS
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


MURRIEL E. CRAWFORD
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2002-0260
Application No. 08/926,872

Page 6

MICHELLE BUGBEE, ASSOCIATE PATENT COUNSEL
SPALDING SPORTS WORLDWIDE INC
425 MEADOW STREET
PO BOX 901
CHICOPEE, MA 01021-0901